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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,879	10/10/2001	Nobuo Oi	2185-0579P	4442

2292 7590 06/13/2003

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EXAMINER
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RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

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DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A 29

**Office Action Summary**

Application No.

09/972,879

Applicant(s)

OI ET AL.

Examiner

Jane J Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5,7,9,11,13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7,9,11,13,15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

1. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being unpatentable by Iseki et al. (6288193).

Iseki et al. discloses a copolymer of ethylene and a vinyl compound (I) represented by the general formula  $\text{CH}_2=\text{CH}-\text{R}$  (col. 2 line 18) wherein R is a saturated hydrocarbon group (col. 2 lines 18-19), the steric parameter  $E_s$  of the substituent R is from -2.77 to -1.64 (col. 2 lines 20-21) and the steric parameter B1 of the substituent R is from 1.53 to 2.90 (col. 2 lines 22-23), wherein the copolymer substantially has no crystallinity (col. 4 line 13-15). Iseki et al. discloses that the content of a unit derived from the vinyl compound (I) in the copolymer is from 5-90mol% (col. 4 lines 45-53). Iseki et al. discloses that the substituent R in the vinyl compound (I) is a secondary alkyl group (col. 11 lines 27-29). Iseki et al. discloses that the vinyl compound (I) is vinylcyclohexane (col.8 line 45). Iseki et al. discloses a molded article comprising the copolymer described above (col. 28 line 6). Iseki et al. discloses that the molded article

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is a film (col. 28 line 6). Iseki et al. discloses that the adhesive comprising the copolymer is the effective ingredient (col. 28 lines 5-17). Iseki et al. discloses that the laminate comprises the copolymer described above (col. 28 lines 18-29).

***Response to Arguments***

2. Applicant's arguments filed 3/31/03 have been fully considered but they are not persuasive.

In response to applicant's argument that Iseki discloses an ethylene based crystalline polymer composed of ethylene based monomer and a vinyl compound because the ethylene based monomer has a melting temperature of 119C or lower therefore accounts for the crystallinity, Iseki discloses that when the melting temperature is more than 119C, than the transparency deteriorates and the impact strength decreases due to high crystallinity (col. 4 lines 13-15) therefore, a lower melting point will give a lower crystallinity for the purpose of obtaining excellence in transparency and mechanical strength or viscoelasticity and since applicant claims a substantially zero crystallinity, a very low melting point can be derived from Iseki's formulas in particular in col. 4 lines 10-12 and furthermore be defined as a substantially low to zero crystallinity.

In response to applicant's argument that a higher content of the polymerization unit in the cited reference produces a crystalline polymer, Examiner disagrees. Iseki discloses that a higher content of the polymerization will give a lower melting temperature therefore in return the polymer will have a substantially very low crystallinity depending on the amount of content of the polymerization unit (col. 4 lines 16-28).

In response to applicant's argument that the polymerization catalyst that produces the copolymer of the present invention is neither disclosed or suggested by Iseki and that the present invention cannot be produced from the catalyst disclosed by Iseki, the process on how the product is made is given very little patentable weight. The end product itself is focused on after the process has been completed, it is the end product of the present invention that is being examined.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jane Rhee  
June 4, 2003

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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6/12/03